



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit :
Examiner: :
In re Application of :
RAVI HARIPRASAD, et al. :
Serial No. 10/728,249 : Atty. Docket No.: 291966-00003
Filing Date: December 4, 2003 :

**PETITION TO ACCEPT A DECLARATION SIGNED BY ASSIGNEE UNDER
37 C.F.R. §1.47 (b)**

September 9, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. The invention which is the subject of the above referenced patent application was invented by Ravi Hariprasad, Rajesh Ghanta, Praveen Ghanta, and Ravi K. Ghanta. The inventors originally assigned the invention to Lucira Technologies, Inc. which filed for bankruptcy on November 27, 2002 in the United States Bankruptcy Court for the District of Massachusetts.

2. The assets of Lucira Technologies, Inc. were sold by the appointed Bankruptcy Trustee to Mobile Secure LLC. PCT Application Number PCT/US01/42001, filed September 4, 2001 was among the assets purchased.

3. Mobile Secure LLC arranged for the filing of U.S. Patent Application No. 10/363,498 on February 27, 2003, and claiming the benefit of the above referenced PCT Application.

4. A notification of missing requirements was mailed on May 20, 2003.

5. Mobile Secure LLC unsuccessfully attempted to obtain a signed declaration from the inventors throughout the next six months. Specifically, Mobile Secure LLC engaged in extensive communications by phone and email with the

inventors requesting that they sign the declaration; provided the declaration along with an assignment to the inventors by overnight delivery, accompanied by a pre-paid overnight return envelope; and held meetings, telephone conversations, and email correspondence with the Bankruptcy Trustee, who then made his own efforts to obtain the signatures of the inventors on the declaration.

6. Mobile Secure LLC's efforts to obtain the signatures of the inventors on the declaration are documented in the Declaration of Duncan Mackay and the exhibits thereto, which is filed herewith.

7. Although the inventors eventually returned signed assignments, they never returned a signed declaration.

8. Mobile Secure LLC's ownership of the application is established by the statement under 37 C.F.R. §3.73 filed herewith, along with the assignments attached to that statement.

9. The last known addresses of the inventors are:

Ravi Hariprasad, 15 Sleeper Street, STE 404, Boston, Massachusetts, 02210;

Rajesh Ghanta, 60 CharlesGate West, Apt. 4B, Boston, Massachusetts, 02215;

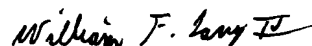
Praveen Ghanta, 4 Marion Street, Hicksville, New York, 11801; and

Ravi Ghanta, 567 Tremont Street, Apt. 11, Boston, Massachusetts, 02218.

10. This petition is accompanied by the petition fee of \$130.

Accordingly, Mobile Secure LLC respectfully requests that the U.S. Patent and Trademark Office accept a Declaration signed by Duncan Mackay, Managing Partner of Mobile Secure LLC, in lieu of a Declaration signed by the inventors.

Respectfully submitted,



William F. Lang IV

Registration No. 41,928

Eckert Seamans Cherin & Mellott, LLC

600 Grant Street, 44th Floor

Pittsburgh, PA 15219

Attorney for Applicant

412/566-2024



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit

Examiner:

METHOD AND SYSTEM FOR TRACKING AND
CONTROLLING A REMOTE DEVICE

In re Application of

RAVI HARIPRASAD, et al.

Serial No. 10/728,249

: Atty. Docket No.: 291966-00003

Filing Date: December 4, 2003

DECLARATION OF DUNCAN MACKAY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Duncan Mackay, hereby state the following:

1. I am the Managing Partner of Mobile Secure LLC.
2. This declaration is being filed in support of the Petition to Accept a Declaration Signed by Assignee under 37 C.F.R. § 1.47(b).
3. The assets of Lucira Technologies, Inc. were sold by the Bankruptcy Trustee of Lucira Technologies to Mobile Secure LLC. PCT Application Number PCT/US01/42001, filed September 4, 2001, was among the assets purchased.
4. Mobile Secure LLC arranged for the filing of U.S. Patent Application No. 10/363,498 on February 27, 2003, and claiming the benefit of the above referenced PCT Application.
5. A notification of missing requirements for the '498 Application was mailed on May 20, 2003.
6. Mobile Secure LLC unsuccessfully attempted to obtain a signed declaration from the inventors throughout the next six months. Specifically, Mobile Secure LLC engaged in extensive communications by phone and email with the inventors

requesting that they sign the declaration; provided the declaration along with an assignment to the inventors by overnight delivery, accompanied by a pre-paid overnight return envelope; and held meetings, telephone conversations, and email correspondence with the Bankruptcy Trustee, who then made his own efforts to obtain the signatures of the inventors on the declaration.

7. Although the inventors eventually returned signed assignments, they never returned a signed declaration.

8. Exhibit A to this declaration is the original letter sent to the inventors by Scott Hilchey of Mobile Secure LLC.

9. Exhibit B is an email response from Ravi Hariprasad to Scott Hilchey.

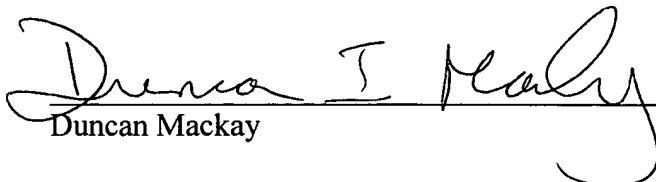
10. Exhibit C is a chain of email correspondence between, Ravi Ghanta and Ravi Hariprasad, two of the original inventors, and Scott Hilchey of Mobile Secure LLC wherein both inventors object to signing the documents.

11. Exhibit D is an email from Joseph G. Butler, the Bankruptcy Trustee for Lucira Technologies, Inc., explaining the limits on his ability to compel the inventors to sign the declaration.

12. Exhibit E is a memorandum prepared by Scott Hilchey summarizing the efforts of Mobile Secure to obtain signed declarations and assignments from the inventors.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment or both under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of an application or any patents issued thereon.

Respectfully Submitted


Duncan Mackay

Dated: 8/23/04

Mobile Secure LLC

67 Foster Street
Peabody, Massachusetts 01960
[t] 617.905.5430

VIA FAX: 206-666-5601

July 9, 2003

Ravi Hariprasad
15 Sleeper St., STE 404
Boston, MA 02210

RE: Patent Application Assignment from Lucira Bankruptcy Proceedings

Dear Ravi:

Enclosed, please find the following documents from Fish & Richardson P.C. concerning the patent that you, Rajesh, Praveen and Ravi G. originated for "*A Method and System for Tracking and Controlling a Remote Device.*"

- U.S. Patent and Trademark letter requesting that the a missing requirement for a declaration transferring the patent application rights from the originating patent applicants to the new applicants
- A combined Declaration and Power of Attorney enabling Fish & Richardson to proceed with the patent process
- A standardized assignment of the patent application rights (something that should have been completed at the time of the bankruptcy) as drafted by Fish & Richardson

Please sign and date the two documents in the places indicated for your name as well as have your signature notarized as required. It needs to be sent to:

Faustino Lichauco
Fish & Richardson P.C.
225 Franklin St.
Boston, MA 02110-2804
617.542.5070

It would be very much appreciated if you send this to him no later than July 15th so that we can have it filed in time with the U.S. Patent and Trademark office.

Thanks for your help!

Kindly yours,



Scott L. Hilchey
MOBILE SECURE LLC

cc. Praveen Ghanta
Rajesh Ghanta
Ravi K. Ghanta
Faustino A. Lichauco, Fish and Richardson P.C.
Duncan MacKay, Mobile Secure LLC
Joseph G. Butler, Barron & Stadfeld P.C.

Mobile Secure LLC

67 Foster Street
Peabody, Massachusetts 01960
[t] 617.905.5430

July 9, 2003

Rajesh Ghanta
60 CharlesGate West Apt 4B
Boston, MA 02215

RE: Patent Application Assignment from Lucira Bankruptcy Proceedings

Dear Rajesh:

Enclosed, please find the following documents from Fish & Richardson P.C. concerning the patent that you, Ravi H., Praveen and Ravi G. originated for "*A Method and System for Tracking and Controlling a Remote Device.*"

- U.S. Patent and Trademark letter requesting that the a missing requirement for a declaration transferring the patent application rights from the originating patent applicants to the new applicants
- A combined Declaration and Power of Attorney enabling Fish & Richardson to proceed with the patent process
- A standardized assignment of the patent application rights (something that should have been completed at the time of the bankruptcy) as drafted by Fish & Richardson

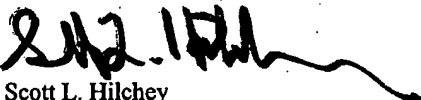
Please sign and date the two documents in the places indicated for your name as well as have your signature notarized as required. I have enclosed a Federal Express return envelope for your convenience directed to:

Faustino Lichauco
Fish & Richardson P.C.
225 Franklin St.
Boston, MA 02110-2804
617.542.5070

It would be very much appreciated if you send this to him no later than July 15th so that we can have it filed in time with the U.S. Patent and Trademark office.

Thanks for your help!

Kindly yours,



Scott L. Hilchey
MOBILE SECURE LLC

cc. Ravi Hariprasad
Praveen Ghanta
Ravi K. Ghanta
~~Faustino A. Lichauco, Fish and Richardson P.C.~~
Duncan MacKay, Mobile Secure LLC
Joseph G. Butler, Barron & Stadfeld P.C.

July 9, 2003

Mobile Secure LLC

67 Foster Street
Peabody, Massachusetts 01960
[t] 617.905.5430

July 9, 2003

Ravi Ghanta
567 Tremont Street Apt 11
Boston, MA 02218

RE: Patent Application Assignment from Lucira Bankruptcy Proceedings

Dear Ravi:

Enclosed, please find the following documents from Fish & Richardson P.C. concerning the patent that you, Rajesh, Praveen and Ravi H. originated for *"A Method and System for Tracking and Controlling a Remote Device."*

- U.S. Patent and Trademark office letter requesting that the a missing requirement for a declaration transferring the patent application rights from the originating patent applicants to the new applicants
- A combined Declaration and Power of Attorney enabling Fish & Richardson to proceed with the patent process
- A standardized assignment of the patent application rights (something that should have been completed at the time of the bankruptcy) as drafted by Fish & Richardson

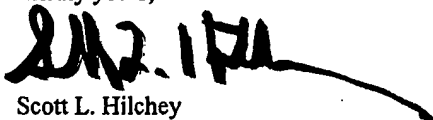
Please sign and date the two documents in the places indicated for your name as well as have your signature notarized as required. I have enclosed a Federal Express return envelope for your convenience directed to:

Faustino Lichauco
Fish & Richardson P.C.
225 Franklin St.
Boston, MA 02110-2804
617.542.5070

It would be very much appreciated if you send this to him no later than July 15th so that we can have it filed in time with the U.S. Patent and Trademark office.

Thanks for your help!

Kindly yours,


Scott L. Hilchey
MOBILE SECURE LLC

cc. Ravi Hariprasad
Praveen Ghanta
Rajesh Ghanta
Faustino A. Lichauco, Fish and Richardson P.C.
Duncan MacKay, Mobile Secure LLC
Joseph G. Butler, Barron & Stadfeld P.C.

Mobile Secure LLC

67 Foster Street
Peabody, Massachusetts 01960
[t] 617.905.5430

July 9, 2003

Praveen Ghanta
4 Marion St.
Hicksville, NY 11801

RE: Patent Application Assignment from Lucira Bankruptcy Proceedings

Dear Praveen:

Enclosed, please find the following documents from Fish & Richardson P.C. concerning the patent that you, Rajesh, Ravi H., and Ravi G. originated for "*A Method and System for Tracking and Controlling a Remote Device.*"

- U.S. Patent and Trademark office letter requesting that the a missing requirement for a declaration transferring the patent application rights from the originating patent applicants to the new applicants
- A combined Declaration and Power of Attorney enabling Fish & Richardson to proceed with the patent process
- A standardized assignment of the patent application rights (something that should have been completed at the time of the bankruptcy) as drafted by Fish & Richardson

Please sign and date the two documents in the places indicated for your name as well as have your assignment signature notarized as required. I have enclosed a Federal Express return envelope for your convenience directed to:

Faustino Lichauco
Fish & Richardson P.C.
225 Franklin St.
Boston, MA 02110-2804
617.542.5070

It would be very much appreciated if you send this to him no later than July 15th so that we can have it filed in time with the U.S. Patent and Trademark office.

Thanks for your help!

Kindly yours,


Scott L. Hilchey
MOBILE SECURE LLC

cc. Ravi Hariprasad
Rajesh Ghanta
Ravi K. Ghanta
Faustino A. Lichauco, Fish and Richardson P.C.
Duncan MacKay, Mobile Secure LLC
Joseph G. Butler, Barron & Stadfeld P.C.

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as attachment

[Move to folder...](#)This message is not flagged. [[Flag Message](#) - [Mark as Unread](#)]**From:** "Ravi Hariprasad" <ravi@hariprasad.net> | [This is spam](#) | [Add to Address Book](#)**To:** "scott hilchey" <shilchey@yahoo.com>, rajesh@ghanta.com, ravih1@rcn.com**CC:** jgb@barronstad.com, dmackay@attbl.com, Ravi@ghanta.com**Subject:** RE: Bankruptcy follow-on for Lucira Patent**Date:** Fri, 27 Jun 2003 16:41:14 -0400

Hi there Scott, et al!

Here's my quick take:

- 1) Re: POA for Ravi Ghanta and Praveen Ghanta I cannot provide this as I not necessarily speak for them. However, I don't foresee any issues with th reassigning their rights to the said patents. Raj: You could probably easi provide contact information for Praveen. I have cc'd Ravi Ghanta on this message so you can contact him directly.
- 2) Meeting at Joe Butler's office: I am no longer in Boston, so meeting in person is not an option. Please advise. However, I do have access to fax.

Best regards,
Ravi

-----Original Message-----

From: scott hilchey [mailto:shilchey@yahoo.com]

Faustino Lichauco

From: Scott Hilchey [shilchey@mobilesecure.com]
Sent: Tuesday, July 15, 2003 8:30 AM
To: lichauco@fr.com
Subject: FW: CLARIFICATION: Patent Documentation & Formalities

Good morning Tino,

Thank you for your call. Here is the most recent correspondence with regard to the patent rights. As mentioned, you should also be getting in the mail a copy of the letters of correspondence to the patent holders.

Scott.

Scott L. Hilchey
MOBILE SECURE LLC
67 Foster Street
Peabody, Massachusetts 01960
shilchey@mobilesecure.com
[m] 617.905.5430

-----Original Message-----

From: scott hilchey [mailto:shilchey@yahoo.com]
Sent: Monday, July 14, 2003 8:45 PM
To: ravi@hariprasad.net; ravi@ghanta.com; rajesh@ghanta.com; praveen@ghanta.com
Cc: dmackay@mobilesecure.com; jgb@barronstad.com
Subject: CLARIFICATION: Patent Documentation & Formalities

Gentlemen,

Sorry! There is a very simple misunderstanding here.

As the originating filers who used **your personal names** for the patent application, the U.S. Patent and Trademark office requires of you as the APPLICATION originators a formal verification, acknowledging that you have transferred the rights to your patent APPLICATION to another - Mobile Secure LLC - to prevent contention in the future.

All that is being requested of you is your verification via signature that you have no claim on the patent APPLICATION that you commenced, but chose not to complete several years ago as the application's originators. It is really just a bit of bureaucracy required by US P& T.

That's it. There is no work, further obligation or request being made of you - Promise. I hope this clears it up and I apologize if I caused a scare. I have cc'ed Mr. Butler on all the communications so that he too understands the formality required by US P&T and he can feel free to speak to the folks at Fish & Richardson to verify this information should he need to.

I very much appreciate your willingness to help us keep the patent application process rolling by sending your signed forms to Fish and Richardson prior to Friday the 18th so that we don't have to file yet another extension.

kindly yours,

7/15/2003

Scott

Ravi Hariprasad <ravi@hariprasad.net> wrote:

Hey Scott,

I've been out for a bit and am just getting caught up. Yes, I did get your fax. However, is your deadline seriously tomorrow!? Moreover, I too take issue with the clause that would compel us "for no further compensation" to do whatever is needed to get these patents filed. Clearly this was an oversight on your part? Filing a patent will take a tremendous amount of "technical" skill to both write, verify and execute. Given MobileSecure's unwillingness to work with us, I can't possibly see how this was your intent.

It's also important to point out that, as Ravi did, that I do not have rights to those patents. I've not had rights since the time of our first financing event where the founders relinquished ownership of the IP to Lucira. Certainly you're initial bridge funding documents also forced IP transfer documents as well to Lucira.

I had a chance to speak with Butler and his opinion is that Lucira owned the patents and you purchased them from him. He is willing to sign anything within reason to help effectuate the patents – plus he's local in Boston. So I am thinking that a photocopy of your signature pages from the bridge financing plus a short statement from Butler should do the trick. Moreover, he did verify that none of us have any further obligations to Lucira or its estate.

Please advise,
Best,
Ravi

Ravi Hariprasad

E-mail: ravi@hariprasad.net

-----Original Message-----

From: Ravi Kiran Ghanta [mailto:ravi@ghanta.com]

Sent: Sunday, July 13, 2003 10:25 PM

To: shilchey@yahoo.com

Cc: ravi@hariprasad.net; rajesh@ghanta.com; praveen@ghanta.com

Subject: Patent Documentation.

Scott:

Hi. I received your patent documents for signature. I have no problem relinquishing rights over the patent application filed 3 years ago to your LLC, however I believe you probably already own them when you acquired Lucira through the bankruptcy auction. All of the inventors listed on the application signed over their property rights to Lucira during the first round of funding. These documents should be on file. You could probably get them from the bankruptcy trustee.

The paperwork you sent over requires a signature from a notary. As you can imagine, as a busy surgical resident, I hardly leave the hospital and finding such a notary would be very difficult. I have not had any business dealings with Lucira in the last 3 years, so I don't feel it to be my responsibility to perform any work that requires significant effort without any compensation. The document you sent over does state that we are to assist in filing the application. I have no such interest in doing so, as I have no time to become involved.

I do not speak for the others, but I'm sure this is on their mind as well.

7/15/2003

I wish you the best of luck in your new venture.

Sincerely,
Ravi Ghanta

Scott L. Hilchey
P.O. Box 1196
Brookline, Massachusetts 02446 USA
USA mobile +1.617.905.5430
UK mobile +44.(0)776.974.3922

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7/15/2003

Scott Hilchey

From: Joseph Butler [jgb@barronstad.com]
Sent: Saturday, July 19, 2003 12:44 PM
To: 'Scott Hilchey'
Subject: RE: assignment search for parent of PCT application

I am going to be around pretty much all day on Monday. Call me. My direct dial is 617 531 6558.

-----Original Message-----

From: Scott Hilchey
To: 'Joseph Butler'
Sent: 7/18/2003 8:58 PM
Subject: RE: assignment search for parent of PCT application

Mr. Butler - Joe if I may - I do need your help to get the proper assignment of patent application rights completed - do you have any time on Monday afternoon between 8:00am and 10:00am or 2:00pm and 4:00pm?

Scott Hilchey

Scott L. Hilchey
MOBILE SECURE LLC
67 Foster Street
Peabody, Massachusetts 01960
<mailto:shilchey@mobilesecure.com> shilchey@mobilesecure.com [m] 617.905.5430 -----

Original Message-----

From: Joseph Butler [mailto:jgb@barronstad.com]
Sent: Friday, July 18, 2003 10:12 AM
To: 'shilchey@mobilesecure.com'; Joseph Butler
Cc: dmackay@mobilesecure.com; 'Faustino Lichauco'
Subject: RE: assignment search for parent of PCT application

Mr. Hilchey,

I think it is important to establish what Mobile Secure purchased. If you look at the bill of sale, it says that I, as trustee of Lucira Technologies "grant, sell, transfer, and deliver to the Purchaser all of the Trustee's, the estate's and the Debtors' right, title and interest to and in" certain personal property, including "Lucira's PCT application (exp. March '03) for international filing, rights to MobileSecure core technology platform and all patent work-in-progress, as well as all copyrighted information, trademarks and tradenames, as well as the exclusive rights to use any of the foregoing" It also says "THE TRUSTEE MAKES NO WARRANTIES OR REPRESENTATIONS OF ANY KIND, EXPRESS OR IMPLIED, WITH RESPECT TO THE ASSETS. THE ASSETS ARE BEING SOLD "AS IS" AND "WHERE IS".

Similarly the Notice of Intended Sale which was circulated states that "The sale is to be AS IS and WHERE IS WITHOUT ANY WARRANTY by the trustee." and the Motion for authority to sell states that the Trustee is selling "any patent rights" that the Debtor might have with respect to the Mobilesecure software. The bill of sale also provides that "The Trustee agrees that he shall execute and deliver or cause to be executed and delivered from time to time such instruments, documents, agreements, consents, and assurances and take such other actions as the Purchaser reasonably may require to more effectively convey, transfer to and vest in Buyer title to the Assets and to carry out the intent and purpose of this instrument." I would like Mobile Secure to get the benefit of the bargain that was struck. If I understand the problem correctly, there is a "parent application of the PCT application" which apparently is in the name of Ravi Hariprasad (and possibly others) and no assignment of that application to Lucira has been recorded with the Patent and Trademark Office ("PTO"). Mr. Lichauco says in his e-mail to you that "it is routine to secure an assignment from the inventors and record it at the PTO promptly." If there is such an assignment in existence, but not recorded, I would certainly confirm that Mobile Secure has purchased Lucira's rights in that assignment. If, despite the fact that it is apparently routine to secure such an assignment, one was never executed, then the question would become whether Lucira has or had any right to compel Mr. Hariprasad (or

others) to assign his/their rights to the parent application to Lucira. If Lucira had that right, then I believe that MobileSecure has acquired that right and it can compel Mr. Hariprasad (and possibly others) to assign their rights. I do not regularly do this kind of work but suspect that, if there were employment agreements between Lucira and Mr. Hariprasad (and any other former employees), the rights of both Lucira and the former employees to any patent applications may be spelled out in those agreements. Let me know if I can be of any assistance and whether you still wish to meet. I am around this afternoon, or Monday. Joseph G. Butler Barron & Stadfeld, PC 50 Staniford Street Boston, MA 02114
(617) 531 6558
(617) 523 8359 [fax]

-----Original Message-----

From: Scott Hilchey [mailto:shilchey@mobilesecure.com]
Sent: Thursday, July 17, 2003 11:56 AM
To: jgb@barronstad.com
Cc: dmackay@mobilesecire.com; 'Faustino Lichauco'
Subject: RE: assignment search for parent of PCT application
Importance: High
Mr. Butler,

It appears that we are not in full receipt of the assets which we purchased from you as the trustee of the Lucira Technologies bankruptcy earlier this year and we need to take immediate action to correct this matter as it is severely limiting Mobile Secure LLC's ability to benefit from the assets it believed it was entitled to.

Pursuant to the below dialogue with our patent counsel, Fish & Richardson, rights to the patent application for "A Method and System for Tracking and Controlling a Remote Device" as commenced by Ravi Hariprasad et al, have not been successfully transferred to Mobile Secure LLC as represented. Our attempt to secure, via signature, these rights directly from the inventors (Ravi Hariprasad, Praveen Ghanta, Ravi. K. Ghanta, Rajesh Ghanta) has been met with objection.

We are seeking an immediate remedy from your office as the failure to secure these rights will severely limit our commercial efforts.

I would like to meet with you as soon as possible to review how we will resolve this matter.

Kindly yours,

Scott.

Scott L. Hilchey
MOBILE SECURE LLC
67 Foster Street
Peabody, Massachusetts 01960

<mailto:shilchey@mobilesecure.com> shilchey@mobilesecure.com [m] 617.905.5430 -----

Original Message-----

From: Faustino Lichauco [mailto:lichauco@fr.com]
Sent: Thursday, July 17, 2003 10:55 AM
To: Faustino Lichauco; 'shilchey@mobilesecure.com'
Cc: 'dmackay@mobilesecire.com'
Subject: assignment search for parent of PCT application

I just wanted to follow up to report that we searched the PTO records for an assignment of record in the parent application of the PCT application.* There was no assignment of record in the PTO files. This is somewhat odd as it is routine to secure an assignment from the inventors and record it at the PTO promptly (to avoid these problems).

We have a filing receipt in our file indicating that the parent U.S. application was filed by Morgan, Lewis and Bockius in Washington D.C. There is also a copy of a letter from a Lesley Coulson of Morgan, Lewis reporting the official filing receipt. The letter is

addressed to one of the named inventors, Ravi Hariprasad, CEO of Lucira Technologies, Inc. (which I imagine is the bankrupt company).

It may be that there is an assignment of the parent application to Lucira that has simply never been recorded.

Tino

*U.S. Application 60/229,312 filed on 9/1/2000

~ Faustino A. Lichauco

Fish & Richardson PC

225 Franklin Street

Boston, Massachusetts 02110

vox:(617)521-7034

fax:(617)542-8906

-----Original Message-----

From: Faustino Lichauco

Sent: Tuesday, July 15, 2003 2:21 PM

To: 'shilchey@mobilesecure.com'

Cc: Faustino Lichauco

Subject: RE: CLARIFICATION: Patent Documentation & Formalities Hello.

I did get the letter thank you. As I mentioned in the letter, we apologize for the delay in reporting the missing parts notice to you. We'll take care of the first extension fee.

At least one of your inventors is a busy surgeon complaining about the need to notarize. Actually, the critical document right now is the declaration, which does not need to be notarized at all. All he has to do is sign it and send it back. In fact, it can even be faxed back. The clock is only running on the declarations. There is no deadline set by the PTO for assignments.

As for the assignments, there is no law that says they have to be notarized. We usually recommend it because if ownership is ever contested, a notarized assignment carries more weight. However, an assignment that is merely signed is certainly not without significant probative value. The assignment can also be executed in front of two witnesses. If it is more convenient, we can prepare an assignment having this feature instead.

I have been looking closely at the PCT file. It seems the PCT application claims priority from US application 60/229,312 filed on 9/1/00. This does not appear to have issued. I have requested our library staff to check the PTO records to see if there exists a recorded assignment for this application, or its progeny (if any). If this is the case, then our assignment problem may be solved because such an assignment would most likely include language assigning all patent applications claiming priority to it.

There are also three provisional applications filed on 5/1/00 that show "CyberTrak Systems" of Philadelphia on the filing receipts. The subject matter seems related so I will have the assignment records for these searched as well.

Tino

~ Faustino A. Lichauco

Fish & Richardson PC

225 Franklin Street

Boston, Massachusetts 02110

vox:(617)521-7034

fax:(617)542-8906

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-----Original Message-----

From: Scott Hilchey [mailto:shilchey@mobilesecure.com]

Sent: Tuesday, July 15, 2003 8:30 AM

To: lichauco@fr.com

Subject: FW: CLARIFICATION: Patent Documentation & Formalities Good morning Tino,

Thank you for your call. Here is the most recent correspondence with regard to the patent rights. As mentioned, you should also be getting in the mail a copy of the letters of correspondence to the patent holders.

Scott.

Scott L. Hilchey

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**Details of Effort to Secure Assignment of Patent Application and
Declaration of Ownership from Inventors**

RE: Relief from the U.S. PCT office for its requirement to provide a declaration of ownership by the inventors concerning the METHOD AND SYSTEM FOR TRACKING AND CONTROLLING A REMOTE DEVICE, Application Serial No. 10/363,498.

Background & Summary

The original inventors and patent applicants of "METHOD AND SYSTEM FOR TRACKING AND CONTROLLING A REMOTE DEVICE" commenced their patent application process on September 4, 2001 in their personal names; RAVI HARIPRASAD, RAJESH GHANTA, PRAVEEN GHANTA, RAVI K. GHANTA.

At some point in late 2001, the four named inventors assigned their rights under their employment contracts to the business formerly known as Lucira Technologies, Inc.

Lucira Technologies, Inc. d/b/a CyberTrak Systems, Inc. failed in August 2002 when it was unable to secure funding to continue operations and filed for bankruptcy on November 27, 2002 with the United States Bankruptcy Court for the District of Massachusetts (Chapter 7, Case No. 02-15659-CJK)

The assets of Lucira Technologies, Inc. were sold by the appointed bankruptcy trustee (Joseph G. Butler, esq., Barron & Stadfeld, PC) the following:

- (1) Lucira.com domain name
- (2) Lucira's PCT application (exp. March '03) for international filing, rights to MobileSecure core technology platform and all patent work-in-progress, as well as all copyrighted information, trademarks and trade names, as well as the exclusive rights to use any of the foregoing application and consult on work needed to complete filing.
- (3) MobileSecure Agent software and source code (on CD)
- (4) MobileSecure Manager web server and source code (on CD)
- (5) Website content and graphics for Lucira.com (on CD)

The successful bidder in the bankruptcy proceedings was Mobile Secure LLC who purchased the above aforementioned property on January 8, 2003.

Mobile Secure LLC continued with the patent process and paid the required fees to extend the patent on February 27, 2003:

[X] was filed on February 27, 2003 as Application Serial No. 10/363,498.

[X] was described and claimed in PCT International Application No. PCT/US01/42001 filed on September 4, 2001.

The materials received by Mobile Secure LLC following the bankruptcy proceedings did not include business records or materials that gave evidence that the original inventors had assigned their rights as patent applicants to Lucira Technologies, Inc.

The US Patent Office communicated with Mobile Secure LLC's patent agent Faustino A. Lichauco, Reg. No. 41,942, of the firm Fish and Richardson, Boston, MA that an assignment of the patent application rights and declaration of ownership to the idea and concept as represented in the patent application "METHOD AND SYSTEM FOR TRACKING AND CONTROLLING A REMOTE DEVICE" were required from the original patent applicants namely; RAVI HARIPRASAD, RAJESH GHANTA, PRAVEEN GHANTA, and RAVI K. GHANTA.

Whereupon, Mobile Secure LLC commenced a 6 month process to secure written assignment of ownership by the original inventors to their former company Luciria Technologies, Inc. as well as their joint declaration of being the original and sole inventor(s) of the concept expressed in the "METHOD AND SYSTEM FOR TRACKING AND CONTROLLING A REMOTE DEVICE" patent application.

Mobile Secure's efforts to obtain both the patent application assignment and declaration from the original inventors included:

- Extensive communications via phone and email (see attached) with the original inventors concerning the need for Mobile Secure LLC to secure the assignment and declaration to continue with the PCT application
- Overnight delivery of the assignment and declaration materials to each inventor inclusive of a pre-paid overnight return envelope
- Meetings, phone conversations and email with the bankruptcy trustee concerning Mobile Secure's needs to secure the assignment and declaration from the original inventors to continue with the PCT application
- The trustee's own direct efforts over a period of months to obtain the assignment and declaration from the PCT application's original inventors

Despite, the above efforts to secure both the PCT application rights and declaration of ownership by Mobile Secure LLC and the trustee of the bankruptcy, the original inventors remained uncooperative and unwilling to perform for some 6 months.

Whereupon, after the persistent efforts over a six month period, Mobile Secure LLC, with the assistance of the bankruptcy trustee was finally in receipt of notarized letters of assignment for the PCT application to the trustee who gave further assignment of the application rights to Mobile Secure LLC.

However, while obtaining the notarized assignment of the PCT application from the trustee, the original inventors namely; RAVI HARIPRASAD, RAJESH GHANTA, PRAVEEN GHANTA, and RAVI K. GHANTA, failed to provide the trustee of the bankruptcy or Mobile Secure LLC any declaration of ownership for the "METHOD AND SYSTEM FOR TRACKING AND CONTROLLING A REMOTE DEVICE"

Consequently, based on the facts expressed here, Mobile Secure LLC seeks consideration and relief from the U.S. PCT office for its requirement to provide a declaration of ownership by the original inventors based on the lengthy and diligent efforts of Mobile Secure LLC and the bankruptcy trustee to obtain said declaration from the named inventors.